

REMARKS

Claims 1-7 are pending in this application. Claim 4 has been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make the invention. Claims 1-3, and 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,896,929 to Dori (hereinafter "Dori") in view of U.S. Patent No. 994,971 to Beck (hereinafter "Beck"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dori and Beck as applied to claims 1-3, and further in view of U.S. Patent No. 4,050,168 to Pace (hereinafter "Pace").

By the foregoing amendments, Applicants have amended the claims to overcome the Examiner's objections and to further clarify the language used in the claims.

Regarding the rejection of Claim 4, Applicants have amended the claims to more particularly describe the blocks as shown in the drawings.

With respect to the rejection of the claims in view of the combination of Dori, Beck and Pace, the Applicants respectfully disagree. The Dori patent relates to a method and apparatus for temporarily displaying a series of repetitive messages on an extended area of compliant ground, such as a beach. The apparatus, as described at column 2, lines 25-44, "includes a roller 20 journaled on a frame 22 coupled at 23

to the draw bar 18 for following the rake 14." Dori is significantly different from the present invention, since, as clearly shown in Figures 1, 2 and 3, the large roller is always in contact with the ground. The large roller is dragged behind a motor vehicle, such as a tractor as shown. Dori does not disclose several significant aspects of the present invention including the activation means which is able to move between a first position in contact with the impressionable medium and a second position which is out of contact with an impressionable medium. Dori, therefore, significantly different than the present invention.

Additionally, should it be proposed by the Examiner that the large apparatus of Dori, which is designed to be dragged behind a motor vehicle, could be "scaled down" to be attached to a ski or snowboard, Dori's roller, which is simply dragged along the compliant ground, would not have enough force to leave an impression upon the compliant ground. Accordingly, Dori lacks several key aspects of the present invention.

Beck discloses a device for large streets or pavements including means (lever 13, rod 14, bell crank joint 15, and link 16) for raising and lowering a chain 17 used for holding letters 27 to selectively engage the letter 27 with the surface. Beck is another example of a stamping apparatus which is designed for use with a motor vehicle. Beck does not show a rotatable drum, nor does it show the simple and effective activation means of the present invention. As with Dori, the system of Beck

is specifically designed for use with a motor vehicle and could not be "scaled down" to meet the needs of the user of the present invention.

Applicants respectfully contend that there is no motivation in either Dori or Beck to combine the teachings of those two patents, to produce the system of the present invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. (MPEP §2143.01, page 2100-126, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990))

Both Dori and Beck disclose large devices that are propelled across a surface by mechanical means (a tractor and an automobile, respectively). Contrast this with the present invention, which relates to a system that is propelled by human power (see, e.g., Figure 4). Based on the size and construction of the roller 20 disclosed in Dori, it would not be physically possible to connect the raising and lowering means disclosed in Beck to the roller 20 to enable it to move on and off the surface. Furthermore, there is no indication in Dori that it would even be desirable to lift the roller 20 off the sand or other surface. In direct contrast with this idea is the fact that Dori contains numerous mentions for providing a series of messages along extended areas; see column 1, lines 29-46 and 52-56 and column 3, lines 18-36.

Additionally, neither Dori nor Beck describe or suggest a base which is designed for sliding across the impressionable medium. This base is an important

aspect of the present invention since it prepares the compliant surface by smoothing out the surface such that the impression means may leave a clear impression. In contrast, the system of Beck discloses no such function. Dori actually teaches away from this function by providing a rake which clearly leaves the compliant ground in an uneven condition. Although this would be acceptable in Dori since the roller has enough weight to leave a clear impression regardless of the uneven nature of the compliant ground, this would be unacceptable with the present invention since the impression means is clearly designed for personal use, and would not have enough weight by itself to leave a clear impression. The activation means provides the necessary force to urge the impression means against the impressionable medium. The novel combination of the base, which smooth the impressionable medium and the manually-activated impression means permit the present invention to leave a clear impression upon the impressionable medium.

It is respectfully submitted that neither Dori nor Beck nor a combination of Dori and Beck arises as the novel solution of the present invention which provides a user-friendly personal identification device for easy and simple mounting to recreational equipment such as a snow ski or a snowboard. Because the present invention is not obvious in over Dori in view of Beck, it is not necessary for Applicants to further distinguish the present invention over Pace.

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Application No.: 09/886,491**

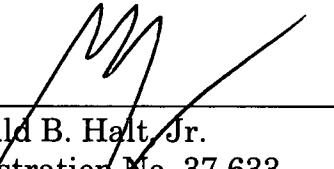
It is respectfully submitted that the amendments made herein place pending claims 1-7 in condition for allowance. Accordingly, entry of this amendment as well as reconsideration and allowance of pending claims 1-7 are respectfully requested.

If the Examiner does not believe that the claims are in condition for allowance, the Examiner is respectfully requested to contact the undersigned at 215-568-6400.

Respectfully submitted,

HALT et al.

By _____


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